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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,692	03/28/2001	Hirokazu Tanaka	ISH-001-USA-CIP	9945

7590 12/24/2002
TOWNSEND & BANTA
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Washington, DC 20005

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,692

Applicant(s)

TANAKA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-17 and 23 are pending. The Amendment filed 11/15/02, Paper No. 9, cancelled claims 18-22, 24-26, and amended claims 1, 2, 5-7, 9 and 23.

Response to Arguments

Applicant's arguments with respect to the 103 rejection over claims 1-17, and 23 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendments to the claims are sufficient to overcome the 35 USC 112 rejections in the previous Office Action.

The submission of the certified copies of the priority documents, PCT/JP91/01087 and Japanese Patent Application H02-216403, and their respective English translations, are sufficient to overcome the 103 rejection in the previous Office Action, as the subject matter of the instant claims was fully disclosed in the Japanese Application filed 8/16/90.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohlschutter et al. (3,922,392).

Kohlschutter et al. teach a process for coating nonporous material with a porous silicone dioxide layer. The nonporous materials are coated with a porous silicon dioxide layer by coating the nonporous material with a polymeric alkoxysiloxane and then subjecting this coating to a

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hydrolytic polycondensation with an aqueous base solution, and drying the product. Inorganic material, preferably glass, is employed as the nonporous material. Synthetic silicates which can be present in the form of scales, such as clay, kaolin, bentonite, and mica, are disclosed as other materials that can be used in place of glass. The particle size of the material is 1 to 500 micrometers. Tetraethoxysilane, tetramethoxysilane, tetrapropoxysilane, and tetrabutoxysilane are disclosed as alkoxysiloxanes. A method is disclosed wherein the nonporous particles are mixed with the liquid polyalkoxysiloxane, wherein the polyalkoxysiloxane is employed as a solution in a readily removable solvent. The product is then filtered, washed, and dried. Spherical particles are disclosed wherein the layer thickness is about 1/10 to 1/500 of the diameter of the solid bodies. The reference lacks an exemplification of the instant method, wherein spherical SiO₂ particles and a flaky or scaly base are used to make a flaky, fine powder. See Col. 1, line 54-Col. 4, line 48; Col. 5, line 54-Col. 7, line 60.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kohlschutter et al. to exemplify a method comprising adding alkoxysilane solution to a dispersion of flaky or scaly base of mica, talc or platelet shaped silica, and spherical SiO₂ particles, because a) Kohlschutter et al. exemplify a method wherein spherical glass beads are combined with an alkoxysilane solution, and b) in Col. 1, line 54-Col. 2, line 12, Kohlschutter et al. teach that glass and synthetic silicates in the form of scales, such as mica, are interchangeable nonporous materials; thus, one of skill in the art would be motivated to substitute one nonporous material for the other because of the expectation of producing similar coated materials for chromatography that do not pass into the body or interior of the core.

Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohlschutter et al. as applied to claims 1-11 and 23 above, and further in view of Bernhard (4,509,988).

Kohlschutter et al. is applied as discussed above. The reference lacks cosmetics.

Bernhard teaches nacreous pigments based on mica flakes and coated with metal oxides, such as silicone dioxide. The pigments are disclosed for use as cosmetics.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the nonporous material coated with a porous silicon dioxide layer of Kohlschutter et al. as a cosmetic because a) Bernhard and Kohlschutter et al. both teach mica flakes coated with silicone dioxide and Bernhard teaches these compounds as cosmetic pigments that have improved light fastness and weathering fastness; thus, one of skill in the art would be motivated to teach the compounds of Kohlschutter et al. as cosmetics because of the expectation of achieving a cosmetic pigments with improved light and weathering fastness.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
December 16, 2002


SREENI PADMANABHAN
PRIMARY EXAMINER

12/20/12